

Appl. No. 10/030,659  
Amdt. dated (Saturday) 15 November 2003  
Reply to Office action of 26-Sept-03

### Remarks/Arguments

#### *Reconsideration Requested*

The applicant has given careful consideration to the grounds of the primary examiner in: (1) rejecting several of applicants' claims under 35 USC §102(b) as being anticipated by a reference to the two patents, US Pat. N<sup>o</sup> 5,078,302 ('302) and US Pat. N<sup>o</sup> 5,474,211 ('211), issued to Hellenberg referencing and showing a colorant-dispensing apparatus adapted for coloring paint base material having several hard-walled storage containers/canisters disposed about a turntable labeled 44 '302 and 14 '211; and (2) rejecting a selection of claims under 35 USC §103 by applying each of the Hellenberg patents '302 and '211 in view of Falcoff *et al.*, US Pat. N<sup>o</sup> 4, 403,866 "Process for Making Paints". All amendments made herein to the claims enjoy full support of applicants' specification, claims, drawings, and abstract as filed; no new matter has been included. For the following reasons, applicants respectfully solicit reconsideration the examiner's rejections.

#### *Claim Rejections under 35 USC § 102*

Applicants' claims 1-3, 6, 13, 14, 16-19 and 21 stand rejected by the examiner under 35 U.S.C. §102(b), as "being anticipated by Hellenberg (US 5,078,302)." Applicants' claims 1-3, 13, 14, 16-19 and 21 stand rejected under 35 U.S.C. §102(b), as "being anticipated by Hellenberg (US 5,474,211)." Each of these patents show a colorant-dispensing apparatus adapted for coloring paint base material having several hard-walled storage containers/canisters disposed about a turntable labeled 44 '302 and 14 '211. The examiner states that the hard-walled container/canister specifically referenced in Hellenberg '302 is that shown in Edstrom *et al.* (US 4,027,785). Edstrom *et al.* is limited to (col. 3, lines 4-6): "The canister 27 is a cylindrical, stainless steel tube 34 the lower end of which is seated in an annular slot 35 in the base 26." In describing its FIGs. 1 and 2, at the bottom of col. 2 – top of col. 3 of Edstrom *et al.* explain:

The colorant dispenser unit 25 consists generally of a base, indicated generally at 26, which is preferably a plastic molding; a canister, indicated generally at 27, which is supported upon the base; a first vertically oriented measuring piston pump 28 which is mounted upon the base 26 alongside the canister 27; a second vertically oriented measuring piston pump 29 which is also mounted upon the base 26 alongside the pump 28; and a colorant intake and discharge system, indicated generally at 30, which includes a system of passages in the base 26 which connect with a horizontal bore 31 in the base, and a barrel valve member, indicated generally at 32, which is rotatably mounted in the bore 31 to control the flow of colorant between the canister 27 and the pumps 28 and 29, and between the pumps and a single exit port 33 which is in a vertical plane between the axial planes of the pumps 28 and 29.

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Applicants have amended their claim 1 to include a flexible-walled vessel (marked-up version):

a plurality of vessels, each vessel is flexible-walled with an associated first flow channel hermetically extending from an exit port and is arranged on a support structure and oriented for dispensing a fluent substance through at least said ~~one~~ exit port and said [[a]] first flow channel, each said first flow channel in further communication with a dedicated measurement assembly and a second flow channel;

Applicants' method claim 13 now includes, likewise, a step associated with employing a flexible-walled vessel that has been pre-filled (reproduced below as marked-up):

arranging a plurality of flexible-walled vessels on a support structure of the apparatus, at least one of said vessels having been pre-filled with a fluent substance and having a first flow channel hermetically extending from an exit port;

Claim 18 now includes further distinguishing features (reproduced below as marked-up):

. . . method of Claim 13 wherein said step of arranging a plurality of flexible-walled vessels further comprises hanging each of said flexible-walled vessels on a framework of said support structure; and further comprising the steps of: positioning a mixture receptacle on said receptacle support; collecting said dosed fluent substance in said mixture receptacle; and further according to said first input, automatically moving a framework of said support structure so that said second flow channel associated with said respective vessel is no longer in said operative relation with said receptacle support, and locating [[a]] another of said second flow channel channels that is in communication with a second one of said plurality of vessels over said receptacle support.

Independent claim 21 now includes a feature admittedly missing from either Hellenberg patent:

a titration module and a mixer, each stationed in positional relationship with a receptacle support.

As the examiner has recognized in allowing certain other of applicants' claims—which have been rewritten in independent form and amended herein—there is no reference in either Hellenberg '302 or '211 to the added features that make applicants' claimed combinations, unique. In their specification, applicants reference a new 'bag-type' technology having certain features such as those shown in commonly-owned patent application pub. **US 2003/0080140 A1** filed in early-2001 and having two common applicants with the instant application (for reference, **US 2003/0080140 A1** is a continuation of International Application N<sup>o</sup> PCT/US99/17280, filed

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30 July 1999, which claimed the benefit of U.S. Provisional Application Nos. 60/094,803, 60/094,831, and 60/094,896 each filed 31 July 1998). In their specification, a couple of passages reproduced below for handy reference, applicants provide background information about a 'bag-type' technology, distinguishing their apparatus and method from other technologies. For example, in lines 26 through the end of page 2 of their specification, applicants' state:

Unlike the labor-intensive processes currently available, the new apparatus and associated method require much less intervention by a lab technician, line worker, etc. and provides sufficient production quality control over batch sizes of hundreds of flasks of prepared mixtures. As can be appreciated, within the spirit and scope of the design goals contemplated hereby, and as further described herein, many different types of suitable alternative structures for carrying out specified function(s) may be incorporated into the new apparatus and method of the invention. Further, the incorporation of flexible-walled vessels ('bag-type') having novel features invented by certain of the listed applicant-inventors hereof, and assigned to the assignee hereof, helps address problems associated with cumbersome transport and storage of heavy, breakable ceramic (e.g., glass) hard-walled containers. These unique flexible-walled vessels can be fabricated from many suitable materials into many different shapes and sizes, and filled with countless different types of fluent substance ingredients as needed for preparing desired mixtures.

Further in applicants' specification (bottom of pg. 3 through top of pg. 4), they point out:

(e) Process speed and reliability/repeatability-- Reducing the need for trained technicians to carry out each of the meticulous steps required to prepare the mixture(s), allows the process of preparing to occur at a faster rate, while being less prone to error (repeatability increases). This makes it possible to more-economically prepare a variety of preselected mixtures (regardless of batch quantities and/or product mix/variety requirements throughout a given day).

(f) Compact/efficient design-- To optimize production, several apparatuses (built with a smaller footprint) can be positioned at different locations within a production or lab environment and operated simultaneously, or sequentially, to create different, or the same, mixtures. The use of flexible-walled bag type vessels, makes possible, on-the-fly replacement thereof.

As one can appreciate, the apparatus and method claimed by applicants' is distinguishable from both Hellenberg patents as, missing from each of these patent disclosures are several of applicants' claimed features.

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***Claim Rejections under 35 USC § 102 / Anticipation – Legal Summary***

As we know: "For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference . . . These elements must be arranged as in the claim under review . . .," *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). The Federal Circuit has reiterated that "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention, [*Scripps Clinic & Research Foundation*]" A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). An anticipation rejection under §102 can stand against a pending claim *only* if a single piece of prior art discloses a combination including *each* element of the pending claim such that each prior art element is identical to a corresponding, similar structurally-arranged element of the pending claim. This is not the case, here. For reasons enumerated above, applicants submit that their independent claims as well as each dependent claim depending therefrom, include features not disclosed in, and not taught or suggested by the Hellenberg patents.

***Claim Rejections under 35 USC § 103***

Applicants' claims 9, 10, and 12 stand rejected under 35 U.S.C. §103(a) as unpatentable over Hellenberg '302 in view of Falcoff *et al.* Applicants' claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hellenberg '211 in view of Falcoff *et al.* On pages 4 – 5 of the office action, the examiner points out that each of these references do not show or suggest certain of applicants' claimed features, particularly, the mixer assembly. This is due in large part to the fact that each of these three references has no need for the combination of features invented and claimed by applicants.

In addition to the comments made above in connection with the examiner's rejection under §102 concerning Hellenberg '302 and '211, the focus of Falcoff *et al.*, similar to that of the Hellenberg patents, is solely on making paint that matches color of a standard liquid paint. There are no details provided about vessel 13 or the walls of the tinting solutions labeled 7 – 12; there is no detail of any associated valves or passageways for dispensing from the tinting solutions and no detail as to relative location to vessel 13, and so on. Falcoff *et al.* is focused on

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'process', namely, one which will suitably colorize paint. There is no need or reason identified or suggested by either Hellenberg patent or Falcoff, *et al.* to produce the unique apparatus and method claimed by applicants. There is nothing in any of these references leading an artisan to conclude that they ought to be taken together to arrive at applicants' claimed invention.

#### *Claim Rejections under 35 USC § 103 – Legal Summary*

It is a long-standing rule that, when determining the patentable nature of a claimed invention which has two or more elements "the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 221 USPQ 481, 488 (Fed. Cir. 1984). Teachings of the prior art simply cannot be combined when the prior art contains no suggestion or motivation to combine them. See *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984). There can be no suggestion to combine where a reference teaches away from its combination with another source. A reference may be said to 'teach away' when a person of ordinary skill, upon reading the reference, would be discouraged from following a particular path or would be led in a direction divergent from the path that was taken by the applicant (for example, if the reference is combined as has been done, it would produce a seemingly inoperative device). As the Federal Circuit reiterated, see *In re Fritch*, (Fed. Cir. 1992):

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

One must look to see whether an artisan, with the references before him/her, could have made the claimed combination *without the exercise of invention*. Even if a primary reference *might be modified* by one skilled in the art to form the claimed structure, this does not make the modification obvious unless the prior art specifically suggests the desirability and details of the modification, see for reference *In re Laskowski* (Fed. Cir. 1989). It is known that a combination made up of elements taken piecemeal from separate references, where there is no teaching or suggestion to so combine, cannot properly be applied against a claimed invention to render it obvious within the meaning of 35 U.S.C. § 103.

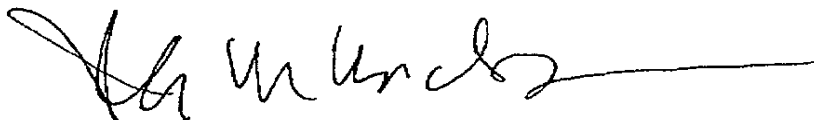
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***Summary/Conclusion and Request for Reconsideration***

Thus, with both Hellenberg '302 and '211 and Falcoff *et al.* silent as to certain claimed features, it is difficult to image how one could be led by either to so combine these references as has been done here to reject applicants' apparatus and method claims, as amended hereby. In sum, after careful consideration of the references, one can see that each fails to disclose, teach or suggest the instant unique claimed invention. A closer look reveals that each reference identified stops short of appreciating or providing any motivation to arrive at the structure claimed in applicants' independent claims. And, although each dependent claim depending from an independent claim containing patentable subject matter is also considered patentably distinct, applicants' dependent claims include further limitations not taught or suggested in any combination of the references cited. Nothing can be found in the references to lead an artisan to try to combine them, and nothing indicates any need to do so.

Each of claims 1 – 21 overcome the examiner's §102 and §103 rejections, each new claim claims a unique combination of features, and as such, all pending claims are patentably distinct from the art. Once again, it is submitted that applicants' claims contain allowable subject matter; therefore, favorable reconsideration is respectfully solicited. Please do not hesitate to call the undersigned to move prosecution forward.

Respectfully submitted,



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